REMARKS

By the above amendment, the claims have been amended in a manner which is considered to overcome the rejections of claims 21 - 43 under 35 USC 112, second paragraph, as will be discussed below.

At the outset, applicants note that the present invention relates to a system for renting to different individual contractors or users at least one electric appliance by a service provider and which recited electric appliance enables sending and receiving information to and from the electric appliance and the service provider. The service provider collects a fee from the individual contractor for the consumed electric power of the electric appliance or appliances rented by the individual contractor in addition to a rental fee for the rented electric appliance or appliances, and the service provider pays an electric power company for the electric power consumed by the rented appliance or appliances of the individual contractor. However, since the electric power fee or rate charge becomes less upon exceeding certain levels of power consumption, and most individual users do not become entitled to such power rate reduction based upon consumption, in accordance with the present invention, the service provider contracts with a plurality of different individual contractors who rent electric appliance from the service provider, and the service provider also contracts with the electric power company to pay a fee based upon the total consumption of electric power of all of the rented appliances of a plurality of different individual contractors so as to obtain a consumed electric power amount substantially greater than any one individual contractor and thereby obtain a reduced electric power rate from the electric power company. In this manner, the individual contractor may pay an electric power rate less than the rate based upon the consumption of electric power by such individual contractor and the electric power

company receives a single payment for total power consumption by a plurality of individual contractors rather than a plurality of individual payments with resulting savings by the individual contractors as well as saving by the electric power company with regard to handling a single large payment rather than small individual payments. Thus, the present invention provides that the service provider includes a rent managing server having features which enable (1) receipt through a network of data on the electric power consumption quantity from the rented electric appliances of the individual contractors; (2) calculation of a fee for the total electric power consumption of all of the electric appliances which are rented by the individual contractors which is paid to the electric power company; and (3) calculates a rental fee for the rented electric appliances of the plurality of individual contractors, which includes a fee for the electric power consumption, and which is generally at a rate less than the rate charged by the electric power company to the individual contractor for the consumption of the power by the rented appliances of such individual contractor. Applicants submit that the aforementioned features are disclosed and recited in the claims of this application, as amended, and that such features are not disclosed or taught in the cited art, as will become clear from the following discussion.

With respect to the rejection of claims 21 - 43 under 35 USC 112, second paragraph, in light of the comments of the Examiner, the claims have been amended to respond to the various points raised by the Examiner.

At the outset, since the Examiner considered the term "use contractors" to be unclear, the claims have been amended to delete "use" and now recite that a service providing company rents to each of a plurality of different individual contractors at least one information electric appliance based upon contracts between the service

providing company and the plurality of different individual contractors. In this regard, the claims have been amended to utilize the term "rent" or variations thereof while eliminating the utilization of "lease" or variations thereof so as to utilize the same terminology throughout. Also, to clarify features of the present invention in light of the examiner's questioning the term "combined", the claims have been amended to clarify that the service providing company, as now recited in claim 21, for example, "receives from the plurality of different individual contractors payment of the rent and pays an electric power company and amount corresponding to the total consumed electric power of all of the rented information electric appliances of the plurality of different individual contractors". Each of the independent claims have been amended in this manner with the dependent claims being amended to utilize similar terminology such that the independent and dependent claims should now be considered to be in compliance with 35 USC 112, second paragraph.

With regard to the Examiner's comments concerning the use of the word "means" in claims 37 and 39, it is noted that the language has been revised to clarify the operation of such means and it is further noted that as to the Examiner's questions as to how electric power is measured, such measurement may be effected by a watt meter such as the watt meter 15 as illustrated in Fig. 1, for example. It is noted that claim 43 has been amended to provide for proper antecedent basis such that applicants submit that all claims should now be considered to be in compliance with 35 USC 112, second paragraph.

As to the rejection of claims 1 - 43 under 35 USC 103(a) as being unpatentable over Mise (2002/0013723 A1) in view of Yablonowski et al (6,535,859), such rejection is traversed insofar as it is applicable to the present claims and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". The court pointed out:

> The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not

> only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In applying Mise to the claimed invention, the Examiner recognizes that "Mise fails to explicitly disclose a managing server having communication means for receiving the data sent from the at least one information electric appliance so that the service providing company receives from the plurality of individual use contractors payment of the rent and pays and electric power company an amount corresponding to the total consumed electric power of the leased information electric appliances of the combined individual use contractors". Thus, applicants submit that the Examiner recognizes that Mise provides no disclosure or teaching that the service providing company provides features (2) and (3), as described above, including feature (2) of calculation of a fee for the total power consumption of all of the rented electric appliances of the individual contractors and pays such fee to the electric power company and/or feature (3) of calculating a rental fee for the rented electric appliances which fee includes the fee for renting and a power consumption fee, as described above and recited in the claims of this application. Accordingly, applicants submit that irrespective of the disclosure of Mise, Mise does not disclose or teach the claimed features of the independent and dependent claims 21 - 43 in the sense of 35 USC 103 and all claims patentably distinguish thereover and should be considered allowable thereover.

The Examiner, recognizing the deficiency of Mise, contends that it would have been obvious to combine Mise with Yablonowski et al to provide the claimed features. However, irrespective of the Examiner's contentions, Yablonowski et al does not overcome the deficiencies of Mise, as pointed out above with respect to features (2) and (3). More particularly, Yablonowski et al relates to a system for

measuring electric power prior to performing energy saving measures, such as replacing the lighting system, and thereafter, after replacement of the lighting system, measures the power consumption, and obtains a difference between the original power consumption prior to the energy saving measures and new power consumption after the energy saving measures, so as to calculate a fee based upon such energy saving matters. However, it is readily apparent that Yablonowski et al does not provide any disclosure or teaching of feature (1) of a service providing company renting to each of a plurality of different individual contractors at least one information electric appliance based upon contracts between the service providing company and the plurality of different individual contractors, nor feature (2) of a service providing company which receives from the plurality of different individual contractors payment of the rent and pays an electric power company an amount corresponding to the total consumed electric power of all of the rented information electric appliances of the plurality of different individual contractors, which feature (2) is also not disclosed or taught by Mise. Thus, it is apparent that the combination of Mise and Yablonowski et al fails to provide feature (2) as described above. Additionally, irrespective of the contentions by the Examiner, applicants submit that the combination of Mise et al and Yablonowski et al also does not disclose or teach feature (3) of calculation of a rental fee including the fee for rent of the rented electric appliance and a fee for electric power, in the manner recited in the independent and dependent claims of this application. Thus, applicants submit that all claims present in this application patentably distinguish over Mise and Yablonowski et al taken alone or in any combination thereof in the sense of 35 USC 103 and all claims should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be considered to be in compliance with 35 USC 112, second paragraph, and all claims patentably distinguish over the cited art and should now be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.40416X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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